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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,036

08/17/2005

Peter Forsell

2333-138

2949

23117 7590 06/04/2007

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER

CHENG, JACQUELINE

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

06/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/530,036

Applicant(s)

FORSELL, PETER

Examiner

Jacqueline Cheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/22/06 4/1/05</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3, 5, 6, 11-13, 15, 16, 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,222,374 (herein referred to as Sampson et al.) further in view of US Patent No. 6,798,193 B2 (herein referred to as Zimmerman et al.). Sampson et al. discloses an apparatus for locating a septum of an injection location. The septum of a device is located under the patient's skin (col. 1 line 18-20) in order to refill a reservoir of the device by injection with a needle through the patient's skin. But after implantation of the device, the septum will shift its position in the body as the patient moves. Sampson et al. discloses using a magnet and a magnetic sensor for the detector for the septum. The magnet comprises a permanent magnet, shaped like a ring (fig. 1 element 10), and/or arranged relative to the septum so to generate a magnetic field external to the patient's skin (col. 2 line 35-42). To detect the magnetic field a magnetic detector is moved along the patient's body over the general vicinity of the implanted device. The detector responds to the magnetic field with a visible indication, which could be an diode or a display, so that the physician can follow these indications to know where to inject the needle (col. 2 line 55-66). What Sampson et al. does not disclose is the magnetic

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sensing device to have a semiconductor circuit and Hall elements. Zimmerman et al. discloses these missing elements. Zimmerman et al. discloses a magnetic sensing element that comprises semiconductor Hall elements (col. 1 line 27-28). It would be obvious to one with ordinary skill in the art at the time the invention was made to combine Zimmerman et al. with Sampson et al. as Sampson et al. discloses that the sensor can be anything that can sense the magnetic field of the implanted magnet. Zimmerman et al. discloses such a sensor.

3. **Claim 4 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sampson et al. in view of Zimmerman et al. further in view of US Patent No. 4,123,772 (herein referred to as Janssen). Janssen discloses a magnetic sensor comprised of semiconductor Hall elements that are grouped in a square configuration (col. 5 line 16-25). It would be obvious to one with ordinary skill in the art at the time the invention was made to combine Janssen et al. with Sampson et al. as the particulars of a Hall element square configuration is well known in the art.

4. **Claims 7-9, 17, and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sampson et al. in view of Zimmerman et al. further in view of US Patent No. 6,839,596 B2 (herein referred to as Nelson et al.). Sampson et al. and Zimmerman et al. discloses most of what is claimed. The only difference is that the positions of the magnetic sensor and device are switched. Nelson et al discloses that having the switched position of having a sensor under the skin and the device above the skin (col. 12 line 51-65, figure 1). Nelson et al. also discloses that the sensor implanted under the skin can send signals out of the body (col. 4 line 37-40). It would be obvious to one with ordinary skill in the art at the time the invention was made to combine

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Nelson et al. with Sampson et al. and Zimmerman et al. because switching the positions of the magnetic sensor and device does not change the function of the locating device. Nelson et al. just shows that having the sensor under the skin is known in the art.

5. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sampson et al. in view of Zimmerman et al. further in view of US Patent No. 4,267,509 (herein referred to as Graham). Although neither Sampson et al. nor Zimmerman et al. discloses that the magnetic detector emits a sound when detecting the local magnetic field, how the physician is alerted of the magnetic field detection is a design choice. One could use the visual indications as disclosed in Sampson et al., or if an operator prefers audible sounds one could emit a sound when the magnetic field is detected. Doing so is even well known in the art as disclosed by Graham. In Graham detection of a magnetic field results in production of an audible sound (col. 9 line 26-30).

6. **Claims 14 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sampson et al. in view of Zimmerman et al. further in view of US Patent No. 5,226,429 (herein referred to as Kuzmak). Kuzmak discloses a gastric band placed around the stomach to treat obesity. The stomach is insufflated with gas and laparoscopic trocars are then placed in the patient's body. After the implantation an injection needle can be used to inject fluid through the injection port (abstract, col. 4 line 49-54, col. 5 line 66-col. 6. line 19). It would be obvious to one with ordinary skill in the art at the time the invention was made to combine Kuzmak with

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Sampson et al. and Zimmerman et al. because after the implantation there needs to be a way to locate the injection port so that the needle and its contents get properly injected.

7. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sampson et al. in view of Zimmerman et al. in view of Nelson et al. further in view Kuzmak. Kuzmak discloses a gastric band placed around the stomach to treat obesity. The stomach is insufflated with gas and laparoscopic trocars are then placed in the patient's body. After the implantation an injection needle can be used to inject fluid through the injection port (abstract, col. 4 line 49-54, col. 5 line 66-col. 6. line 19). It would be obvious to one with ordinary skill in the art at the time the invention was made to combine Kuzmak with Sampson et al, Zimmerman et al. and Nelson et al. because after the implantation there needs to be a way to locate the injection port so that the needle and its contents get properly injected.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4,804,054 to Howson also discloses a device and method for precise subcutaneous placement of a medical instrument.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Cheng whose telephone number is 571-272-5596. The examiner can normally be reached on M-F 10:00-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571-272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC

  
ELENI MANTIS MERCADER  
SUPERVISORY PATENT EXAMINER